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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2617

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04/06/06 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Maisha D. Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2300

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1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Arguments

2. Applicant's arguments filed 04/06/06 have been fully considered but they are not persuasive.

On pages 8, 9 and 13 of applicant's remarks, applicant argues that Jones fails to disclose or suggest any application to a remote handset of a cordless telephone, much less disclose downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 15, 25 and 28.

The examiner, however, disagrees. Jones teaches a MP3 player that downloads digital content files from the Internet (see fig.3, direct connection between Internet 62 and portable device 70), (NOT a PC, as alleged by the applicant), and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"),

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Jones teaches download of digital content files to a portable device (see fig.3, direct connection between Internet 62 and portable device 70) and the combination of Borland and Jones does indeed teach applicant's claimed invention as recited by claims 15, 25 and 28. In addition applicant's attention is directed to the rejection of claims 15, 25 and 28 above. In addition, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *any application to a remote handset of a cordless telephone*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 9 of applicant's remarks, applicant argues that not motivation to combine Borland and Jones.

In response to applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to do so found in the references themselves in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

On pages 9 and 10 of applicant's remarks, applicant argues that Jone fails to teach a cordless telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), and the combination of Borland and Jones does indeed teach applicant's claim limitation. In addition applicant's attention is directed to the rejection of claims 15, 25 and 28 above.

On page 10 of applicant's remarks, applicant argues that "nothing within Borland nor Jones suggests modification of a telephone device to connect to the Internet, much less for downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 15, 25 and 28".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *a telephone device to connect to the Internet*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Jones teaches downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source (see Jones, column 10, lines 9-14) and Borland teaches accessible by the remote handset via an Internet (see Borland, column 4, lines 27-33, see "transmission through Internet") and the combination of the combination of Borland and Jones does indeed teach applicant's claim limitation. In addition applicant's attention is directed to the rejection of claims 15, 25 and 28 above.

On page 11 of applicant's remarks, applicant argues that there is no motivation to combine Borland and Rybeck.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to do so found in the knowledge generally available to one of ordinary skill in the art in order

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to prevent telephone conversation from interfering with audio sounds. In addition, applicant's attention is directed to the rejection of claim 1 above.

On page 12 of applicant's remarks, applicant argues that Rybeck teaches a cellular telephone (not a remote handset of a cordless telephone).

In response, Borland teaches a remote handset of a cordless telephone (see fig.2, 110). In addition, those skilled in the art will appreciate that the teaching of Rybeck can be used in a remote handset of a cordless telephone of Borland without depart from Rybeck's invention since Borland's "a remote handset of a cordless telephone", applicant's "a remote handset of a cordless telephone" and Rybeck's "cellular telephone" are telephone communication devices. Therefore, the combination of Borland and Rybeck teaches applicant's claimed limitation. In addition, applicant's attention is directed to the rejection of claim 1 above.

On page 14 of applicant's remarks, applicant argues that Ng fails to teach a cordless telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone (see fig.2) and the combination of Borland, Jones and Ng applicant's claimed limitation. In addition, applicant's attention is directed to the rejection of claims 14 and 24 above.

On page 14 of applicant's remarks, applicant argues that the combination of Borland, Jones and Ng fails to teach downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source, as recited by claims 14 and 24.

The examiner, however, disagrees. Jones teaches a MP3 player that downloads digital content files from the Internet (see fig.3, direct connection between Internet 62 and portable device 70), (NOT a PC, as alleged by the applicant), and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Jones teaches download of digital content files to a portable device (see fig.3, direct connection between Internet 62 and portable device 70) and the combination of Borland, Jones and Ng does indeed teach applicant's claimed invention as recited by claims 14 and 24. In addition applicant's attention is directed to the rejection of claims 14 and 24 above.

On page 16 of applicant's remarks, applicant argues that Tuoriniemi's playing a stored digital audio program from a personal communication and audio set is NOT

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playing MP3 music from a remote handset of a cordless telephone, much less muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: playing of the pre-loaded MP3 music from the remote handset of a cordless telephone (see column 5, lines 24-28), connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) and playing of the pre-loaded MP3 (column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback"), Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55) and the combination of Borland and Tuoriniemi does indeed teach applicant's claimed limitations of claims 9 and 19. In addition, Borland teaches the method of integrating an MPEG audio player in a cordless telephone according to claims 9 and 19 (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") and Tuoriniemi teaches muting

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the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55) and the combination of Borland and Tuoriniemi does indeed teach applicant's claimed limitations of claims 10 and 20.

For the above reasons, the Examiner believes that the rejections to claims are proper.

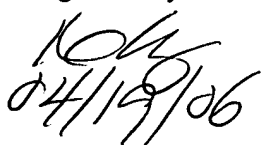
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly



04/19/06